

Attorney Docket No. 7175/65430
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APR 360 #18
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kip Van STEENBURG

Serial No.: 09/660,433 Art Unit: 3673

Filed: September 7, 2000 Examiner: Michael Trettel

For: LEG HOLDER SYSTEM FOR SIMULTANEOUS POSITIONING IN THE ABDUCTION AND LITHOTOMY DIMENSIONS

REPLY BRIEF

Not for filing
Honorable Assistant Commissioner
for Patents
Washington, D.C. 20231

Sir:

This is a reply brief in support of an appeal taken from the final rejection of claims 1-100 mailed May 21, 2002. A notice of appeal was filed November 19, 2002 and the brief was filed January 8, 2003. The examiner's answer was mailed March 25, 2003. The examiner's answer drops the rejection of original patent Claims 1-13.

The examiner's answer at page 3 asserts, in part, that "applicant is attempting to claim the supporting device without any reference to a longitudinal axis and a clamping device having an axis transverse to the longitudinal axis... applicant is now attempting to redefine these axes in broader terms..." and "applicant is also attempting to drop out any reference to a clamping device that can simultaneously clamp and release the supporting device relative to the clamping device about the first and second (longitudinal and transverse) axes."

Claims 14-100 have both narrower and broader limitations when compared to patented claims 1-13. Appellant's brief rebuts the specific claim limitations stated in the final office action as the grounds for recapture. The brief explains how the recapture rule is avoided with respect to each such limitation. The above quoted comments (appearing at page 3 of the examiner's answer) do not discuss or rebut any of appellant's specific arguments. The above quoted arguments are conclusions without proper supportive reasoning. The above quoted arguments do not explain which, if any, of claims 14-100 is broader, in what aspect any claim is broader and how such broader aspect relates to surrendered subject

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matter. The above arguments do not present, with respect to any claim, a *prima facie* case of recapture.

At page 4 of the examiner's answer it is argued that the seven limitations discussed in the final office action and appellant's brief are dropped from independent claims 14, 24, 48, 72, 81 and 91. Thereafter it is urged that

[t]he independent claims therefore removes or broadens almost all the limitations added to old claim 1 during the prosecution in order to define over the Klevstad reference, these limitations were referred to and relied upon extensively in the applicant's arguments as defining over the Klevstad patent. Since these limitations were added in order to secure an allowance any attempt to now drop them out altogether is an attempt at recapture (examiner's answer, page 5).

As noted above, an explanation of why these seven limitations do not provide a basis for recapture in any of appellant's claims 14-100 is provided in detail in the brief. The examiner's assertions to the contrary do not provide any specific argument or grounds to rebut the rationale in appellant's brief.

Further, reliance on dropped limitations in the final office action and the examiner's answer completely ignores the case law which permits dropping of limitations without violating the recapture rule. Dropping limitations in a reissue does not mandate an improper recapture.

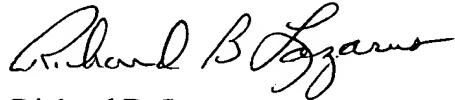
Conclusion of Argument

For all of the reasons in appellant's brief and the above additional reasons, the rejection of claims 14-100 for recapture is improper and should be reversed.

Claims 14-100 are in compliance with 35 U.S.C. 251 and appellant, respectfully, requests reversal of the rejection.

Respectfully submitted,

BARNES & THORNBURG



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